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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,225	10/30/2003	Mary Elizabeth Davis	9396	9781
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EXAMINER				
CHAPMAN, GINGER T				
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3761				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,225

Applicant(s)

DAVIS ET AL.

Examiner

Ginger T. Chapman

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7-12 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date 05/11/2009
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 1-6 and 13-30 are cancelled, claim 1 is amended; claims 7-12 are pending in the application.

Withdrawn rejections

2. The rejection of claims 7-12 on the ground of nonstatutory obviousness-type double patenting is withdrawn in view of Applicants' arguments that the copending application is a division of the instant application which was filed after a restriction requirement.

Response to Arguments

3. Applicant's arguments filed April 7, 2009 have been fully considered but they are not persuasive. Applicant argues the following:

4. (I) Otubo does not expressly disclose that the wetness sensation member disposed on the topsheet is visible, and its visible physical differences that make it visible or visibly different from the topsheet it is disposed upon is done to enhance its ability to provide a wetness sensation and any extrapolation that the presence of the wetness sensation member on the topsheet results in a visible difference is pure speculation.

5. (II) Applicants acknowledge that the visibility of a wetness sensation member resulting from differences in its physical features compared to the topsheet upon which it is disposed is disclosed in the instant Specification as a suitable embodiment of visible highlighting, i.e. undulations, undulating crests 31 and gaps 32, however, Applicants have amended the instant claims to recite that the visible highlighting is an ink-printed pattern made up of a plurality of

repeating figures in order to distinguish over Ostubo and the visible border Neading as the visible border of Neading does not teach the claimed pattern.

6. With respect to (I), the examiner notes that Ostubo teaches, at c. 2, ll. 20-21; c. 5, ll. 6-8 and at c. 6, ll. 40-48, that the presence of the raised undulating crests and troughs comprising the wetness sensation member "progressively becomes remarkable" and "more and more noticeable" due to the wetness sensation member contracting at bond points when exposed to repeated wetting. The examiner further notes that the instant Specification teaches such raised patterns, i.e. combination of raised and recessed areas, or "bumpy" areas, which may serve to temporarily contain small amounts of urine in its depressions and voids between raised portions thereby enhancing wearers' awareness that urination has occurred by adding to the wet feeling of the wetness provided by the structure of the wetness sensation member, as taught by Ostubo at c. 5, ll. 54-65.

7. The examiner notes this is substantially identical in structure and function to the wetness sensation member of Ostubo (see col. 5, ll. 54-64) and therefore maintains that, without speculation, the repeating pattern of physical topographical features i.e. the raised undulating crests and gaps of the wetness sensation member of Ostubo, absent evidence to the contrary, would be visible when the wetness sensation member is disposed upon on the topsheet. Applicant response discussed how the physical structures enhance wetness sensations, but has presented no arguments or evidence supporting the assertion that the wetness sensation member of Ostubo would not be visible.

8. With respect to (II), Applicants' arguments are drawn to the claims as amended and are answered in the rejection below.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsubo et al (US 6,146,367) in view of Neading et al (US 2001/0049513 A1).

12. With respect to claim 7, Otsubo discloses a disposable absorbent article for wearing about a lower torso of a wearer and having a longitudinal axis, two laterally opposed article side edges extending between a laterally extending first waist end edge in a first waist region and a laterally extending second waist end edge in a second waist region, and a crotch region interposed therebetween (figs. 1 and 2), the disposable absorbent article comprising:

13. a backsheet 22;
14. a topsheet 21 joined to the backsheet 22 and having a body facing surface (fig. 2);

15. at least one wetness sensation member 2 (c. 5, ll. 54-65) disposed upon the topsheet 21 in a face-to-face arrangement with the permeable body-facing layer 18 (figs. 3 and 4) and having two laterally opposed side edges (fig. 2), at least a portion of each of the two wetness sensation member 2 side edges being disposed laterally inwardly of the article side edges (fig. 2); and

16. a visible highlighting 31, 32 indicating a presence of the wetness sensation member in the article and being visible at least when viewing the body-facing surface of the topsheet to facilitate an opportunity for urinary toilet training of the wearer (c. 6, ll. 12-15) wherein said visible highlighting comprises a pattern made up of a plurality of repeating figures (c. 4, ll. 5-17 and c. 5, ll. 6-9), teaching a pattern made up of a plurality of repeating crests 31 and gaps 32 undulating longitudinally; disclosed in the instant specification, at p. 10, ll. 4-6 and ll. 25-34 and p. 11, ll. 1-3, as a suitable embodiment of visible highlighting, and wherein said pattern is visible prior to wetting of wetness sensation member, and wherein the appearance of the visible highlighting is substantially unchanged upon wetting of the wetness sensation member, wherein urine deposited by the wearer onto the wetness sensation member 2 can penetrate through the permeable body-facing layer in a z direction away from the wearer to an absorbent core (c. 4, ll. 50-51) and the wetness sensation member retards the passage of urine in the z direction and supports the movement of the urine in an x-y plane such that the wearer's awareness of urination is enhanced (c. 5, ll. 54-65).

17. Otsubo discloses the claimed invention except for expressly disclosing an absorbent core and that the visible highlighting is ink-printed. Otsubo teaches a pattern made up of a plurality of repeating crests and troughs (c. 2, ll. 20-21) which trap urine therebetween in order to enhance wetness sensation to facilitate an opportunity for toilet training, thereby providing motivation for

such. Neading teaches an absorbent core 20, which are well known in the diaper art, and a visible highlighting 24 comprising an ink-printed pattern (that does not repeat) that is visible prior to wetting of a flow control layer 14 in order to provide a visible indicator of wetness to facilitate toilet training; the permeable body-facing flow control layer 14 performs the substantially identical function of the instant claimed wetness sensation member [0024-5]. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form as taught by Neading, since Neading states, at [0025-7], that the benefit of forming the article with this design is that it indicates and thereby creates an awareness that urination and soiling of the diaper has taken place.

18. Additionally, the dictionary definition of pattern is, *inter alia*:

pattern

- **noun 1** a repeated decorative design. **2** a regular or discernible form or order in which a series of things occur: *working patterns*. **3** a model, design, or set of instructions for making something. **4** an example for others to follow. **5** a model from which a mould is made for a casting. **6** a sample of cloth or wallpaper.

- **verb 1** decorate with a pattern. **2** give a regular or discernible form to.

- ORIGIN from **PATRON** in the former sense something serving as a model, from the idea of a patron giving an example to be copied.

19. Therefore, in light of the dictionary definition of pattern as a repeated design (Compact Oxford English Dictionary, available online: AskOxford.com), the examiner notes that when there is an variety of available designs (by way of non-limiting example, patterns can be made up of pluralities of figures that do not repeat for a particular article) then the designer can choose any design he wants; therefore a choice of pattern designs would not lend additional patentable

weight because, absent evidence to the contrary, the choice of design does not appear to have a mechanical function or to result in a structural difference.

20. Therefore the examiner contends that matters relating to ornamentation only, which have no mechanical function and do not result in a structural difference, cannot be relied on to patentably distinguish the claimed invention from the prior art. The particular pattern of the highlighting does not lend additional patentable weight since it appears to be a matter of design choice that a person of ordinary skill in the art at the time the invention was made would find obvious to be able to select a pattern absent persuasive evidence that the particular pattern of the claimed highlighting is significant. Were this not the case, multiple patents could issue indefinitely for the same article merely by changing the design of the pattern.

21. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007)(citing *KSR v. Teleflex*, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly, Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent persuasive evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a). *Ex Parte Smith*, 83 USPQ.2d at 1518-19 (BPAI, 2007)(citing *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396). Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is uniquely challenging or difficult for one of

ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. § 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

22. With respect to claim 8, Otsubo discloses the wetness sensation member 2, comprises sheet having a plurality of crests 31 disposed parallel to and spaced apart from the longitudinal axis and spaced apart 32 from one another, each crest 31 disposed upon the topsheet 21. Thus the configuration of crests of Otsubo performs in the substantially identical manner as a plurality of members in the same configuration.

23. With respect to claim 9, Otsubo discloses the claimed invention except for the spacing of the members ranging from about 5 mm to about 15 mm apart. Otsubo teaches the wetness sensation crests 31 in the crotch region are spaced apart in order to retain urine between each row of crests 31 and in the gaps 32 therebetween to hold the urine against the wearer's crotch to provide a sensation of wetness to alert the wearer that urination has occurred. Thus Otsubo provides motivation for spaced apart wetness sensation members. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the crests of Otsubo space about 5 to about 15 mm apart, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

24. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsubo in view of Neading and further in view of Roe et al (US 6,642,427 B2).

25. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

26. With respect to claims 10-12, the combination of Otsubo / Neading disclose the claimed invention except for the topsheet comprises two z-folds parallel to the longitudinal axis separated by a spacing ranging from about 50 to about 90 mm apart and each wetness sensation member disposed within the z-folds and further comprising two elastic members disposed along the two flow control members. As best depicted in Figures 8b and 10b, Roe discloses the claimed configuration. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the wetness sensation members of Otsubo / Neading as taught by Roe, since Roe states, at c. 11, ll. 17-20, that the benefit of forming the members with this design is that the combination of the z-folded topsheet and elastic members maintains wetness sensation member in contact with the wearer's skin.

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/
Examiner, Art Unit 3761
06/18/09

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/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772